

II. REMARKS

In response to the Office Action mailed 02/02/2010, please enter the amendment and reconsider the application in view of the amendment and remarks set forth below; it is believed that no new matter has been added.

In the Office Action, the Election / Restriction Requirement has been maintained after reconsideration was requested. Claims 6-34, 44-47, 49-50, 53-56, 66-69, 86-114, 124-127, 129-130, 133-136, 146-149, 163-165, and 167-171 have been withdrawn.

In response, Applicant will Petition if the claims are not rejoined.

In the Office Action, claims 1-5, 35-43, 48, 51, 52, 57-65, 70-85, 115-123, 128, 131, 132, 137-145, 150-162, and 166 have been rejected pursuant to 35 U.S.C. Sec. 102(b). The Examiner contends that these claims are anticipated by U.S. Patent No. 6,119,093 (Walker).

In response the rejection is respectfully traversed because the Examiner has not shown that each of the rejected claims is the same as that which is disclosed in Walker.

More particularly, it is respectfully submitted that the claim elements have not been shown in the cited art. Representatively, and of particular note, in view of the above-provided amendment to the independent claims, is the rejection of claim 61. The Examiner states, at page 18, that

The phrase "replacement" is just an identifier and imparts no functionality or structurally limiting scope. Furthermore, an investor that applies to join a syndicate is effectively serving to replace some of the risk previously carried by the insurance company. In this sense, a new investor maybe seen as a "replacement" pool member.

This is all improper for a prima facie Sec. 102 showing. Claim 61 states: wherein one of said terms governs appointing a replacement pool member and thus the term replacement limits the scope of one of said terms, and further applying the terms is in fact a matter of functionality; and thus is not "just an identifier" so as to make out a prima facie showing that the claim is the same as Walker. Rather, the Office Action is ignoring a claim element. Further, "new" is not

the same as “replacement”. Yet further, serving to replace some risk is not the same as wherein one of said terms governs appointing a replacement pool member. This kind of defect in the rejections is common in the Office Action in rejections which, in effect, contend that a claim element is without meaning.

Another kind of defect as it is understood, common in the Office Action, also in effect, contends that a claim element is without meaning. Representatively, consider claim 36. The Examiner concedes that, as to claim 36 “Walker does not expressly teach the specific data recited in claim 36” argues that the conceded claim 36 elements nonetheless are anticipated. The arguing, as is more precisely stated in the Office Action, is in effect that these claim elements are not considered in a Sec. 102 rejection because they are contended to be nonfunctional descriptive information, and thus not entitled to consideration, citing Gulak, Lowery, and Ngai. First, reliance on this case law is improper: Gulak, Lowery, and Ngai pertain to 35 U.S.C. Sec. 101; none of these cases are Sec. 102 decisions. The rejection, as it is understood, seems premised on the idea that any portion of a claim that separately constitutes unpatentable subject matter will not be considered as regards Sec. 102 anticipation. This is an error of law: Sect. 102 is a statute independent of Sec. 101; one is not limited by the other.

Second, even if the specific data were nonfunctional, (and they are not) they definitely are not via claim 40, which is nonetheless is rejected as being anticipated though, according to the Examiner 36 “Walker does not expressly teach the specific data recited”. This is all improper for a prima facie Sec. 102 showing. The same applies to claims 37-39: the rejections are all improper, especially in view of claim 40. The same also applies to claims 43-57: the rejections are all improper, etc.

Prima facie anticipation has not been shown by ignoring claim elements and by applying Sec. 101 case law to Sec. 102 rejections.

However, Applicant has amended the independent claims, carrying forward notions of

“replacement”, and thereby rendering the rejections moot. Walker does not teach or suggest wherein the rules include a requirement for at least one member to assume a larger share of the obligation in the event at least one other member’s share of the obligation is reduced nor rules include at least one rule to appoint at least one new member to replace a member leaving the pool.

Other amendments are to tidy up the claims. For example, claim 161 has been amended to remove “means for” language, not in response to any rejection, but rather because instability in case law since the filing date of this application has made it difficult to predict the future scope of “means for” language.

Applicant requests an in-person interview.

With respect to the present application, the Applicant hereby rescinds any disclaimer of claim scope made in the parent application or any predecessor or related application. The Examiner is advised that any previous disclaimer, if any, and the prior art that it was made to avoid, may need to be revisited. Nor should a disclaimer, if any, in the present application be read back into any predecessor or related application.

III. CONCLUSION

With respect to the present application, the Applicant hereby rescinds any disclaimer of claim scope made in the parent application or any predecessor or related application. The Examiner is advised that any previous disclaimer, if any, and the prior art that it was made to avoid, may need to be revisited. Nor should a disclaimer, if any, in the present application be read back into any predecessor or related application.

The application is believed to be in condition for allowance, and favorable action is requested. If the prosecution of this case can be in any way advanced by a telephone discussion, the Examiner is requested to call the undersigned at (312) 240-0824.

Applicant claims **SMALL ENTITY STATUS**. The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235.

Please direct all correspondence to the undersigned at the address given below.

Respectfully submitted,



Date: August 27, 2010

Peter K. Trzyna
(Reg. No. 32,601)
(Customer No. 28710)

P. O. Box 7131
Chicago, Illinois 60680-7131
(312) 240-0824